



Atty Dkt No. 5100-0707
PATENT

9200
1634
HAC

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on November 15, 2002

11/15/02

Date

Karen Kizer

Signature

#18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Bittner et al.

Serial No.: 09/766,273

Group Art Unit: 1634

Filing Date: January 18, 2001

Examiner: Sakelaris, S.A.

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR
NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN
SITU HYBRIDIZATION

TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed are the following:

- 1) Petition to Withdraw Holding of Abandonment;
- 2) Exhibit A - (copy of Notice of Abandonment);
- 3) Exhibit B - (copy of Mail Logs);
- 4) Supplemental Amendment;
- 5) Statement to Support Filing and Submission;
- 6) Hardcopy of the Sequence Listing;
- 7) Floppy diskette of Sequence Listing; and
- 8) Return postcard.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: November 15/2002

By: Narinder S. Banait
Narinder S. Banait
Registration No. 43,482

ROBINS & PASTERNAK LLP
545 Middlefield Road, Suite 180
Menlo Park, CA 94025
Telephone: (650) 325-7812
Facsimile: (650) 325-7823



Atty Dkt No. 5100-0707
USSN: 09/766,273
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Michael Bittner *et al.*

Serial No.: 09/766,273

Art Unit: 1634

Filing Date: January 18, 2001

Examiner: Sakelaris, S.A.

Title: OLIGONUCLEOTIDE-TAGGED SEMICONDUCTOR
NANOCRYSTALS FOR MICROARRAY AND FLUORESCENCE IN
SITU HYBRIDIZATION

PETITION TO WITHDRAW HOLDING OF ABANDONMENT

Box DAC
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants provide this Petition pursuant to the provisions of 37 CFR §1.181(a) and MPEP §711.03(c)II in order to withdraw a holding of abandonment on the above-identified application. In particular, applicants received a Notice of Abandonment dated October 25, 2002 for failure to timely file a proper reply to the Office letter mailed on March 20, 2002. A copy of the Notice is attached as Exhibit A. However, applicants did not receive the March 20, 2002 letter. It is normal practice to enter the PTO mailings into the MAIL LOG docketing system on a day of the receipt of the mail. Applicants include copies of the docket for the period of March 20, 2002 through April 2, 2002, appended hereto as Exhibit B. The docket indicates that the Office letter was not received.

Accordingly, applicants submit that the application should not have been abandoned and respectfully request that the application be reinstated.

Applicants include a reply to the Office Action mailed on March 20, 2002, as required by MPEP §711.03(c).

The Office is authorized to pay any additional fees which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: November 15/2002

By: Narinder S. Banait
Narinder S. Banait
Registration No. 43,482

ROBINS & PASTERNAK LLP
545 Middlefield Road, Suite 180
Menlo Park, CA 94025
Telephone: (650) 325-7812
Fax: (650) 325-7823

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/766,273

01/18/2001

Michael Bittner

22564-0707

1332

20855

7590

10/25/2002

ROBINS & PASTERNAK LLP
545 MIDDLEFIELD ROAD
SUITE 180
MENLO PARK, CA 94025

RECEIVED**OCT 30 2002****ROBINS & PASTERNAK LLP**

5100-0707

EXAMINER

SAKELARIS, SALLY A

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 10/25/2002

17

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED NSB

5100-0707

Petition to Revive/
Withdraw Holding
of Abandonment
11/30/02



Notice of Abandonment

Application No.

09/766,273

Examiner

Sally A Sakelaris

Applicant(s)

BITTNER ET AL.

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 20 March 2002.

(a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.

(b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).

(c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).

(d) ☒ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

(a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).

(b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.

The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.

(c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).

(a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.

(b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

Carla J. Myers
CARLA J. MYERS
PRIMARY EXAMINER

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

EXHIBIT B

MAIL LOG
March 20, 2002

ATTY DOC # DESCRIPTION
rcv'd via courier 3-19

RLR	7011-XXX	new US provisional patent applications (2)
DSP	6750-xxxx	ltr fr Cooley w/correspondence for transferred files
DSP	8325-0020	ltr re IDS
DSP	8325-0018.40	ltr re do not request Chapter II processing
DSP	8325-0019.40	ltr re do not request Chapter II processing
GRF	2750-0230.01	ltr w/copy of issued patent 6,356,776
RLR	8400-0010	Advisory Action
DSP	2300-1621.41	so.africa copy of executed Assignment
DSP	2300-1527.	Ltr w/copy of Notice of Allowability
RLR	2300-0953.52	cc ltr fr Chang to Chiron re filed Amendment
DSP	6750-0001.40	PCT-Notice Informing the Applicant of the Communication If the Intl...
RLR	2302-1631.20	copy of Declaration of Susan E. Wilson
RLR	7050-0003.10	fr Roche documents for our file
DSP	6750-0007.45	ltr fr Cooley correspondence for transferred files

MAIL LOG
March 21, 2002

<u>ATTY</u>	<u>DOC #</u>	<u>DESCRIPTION</u>
RLR	9000-0057.40	ltr fr Gowlings w/copy of PCT Intl. Search Report
RLR	9000-0055.40	ltr fr Gowlings w/copy of PCT Intl. Search Report
DSP	2300-0999	ltr w/copy of Office Action
RLR	2300-0946.20	ltr w/copy of U.S. Patent 6,355,247
DSP	8325-0007.43	conf. copy ltr fr Mewburn re entering regional phase at EPO
RLR	0800-0008.41	CPA-Official Receipt
RLR	2300-1651.	ltr requesting preparing and filing application
GRF	2750-0209.03	ltr w/copy of Corrected Filing Receipt

March 22, 2002

PTO	Notice of Publication - 09/915,947 (3930-0804.01)
PTO	Not. File Miss. Pts. & OFR - 10/084,826 (8325-0014.20)
PTO	RLR - postcard confirming req. for Cert. of Corr. - Patent # 5,858,351
EP/ISA	DSP - Notif. of Receipt of Search Copy - PCT/US01/49623 (8600-0010.40)
EP/ISA	DSP - PCT/ISA/224 - delay of ISR establishment (8600-0010.40)
TIPLO	RLR - OA, rsp due 3-May-02 (5998-0019.42)
PTO	Decision on petition (Granted) (3941-0001.20)
BGL	RLR - cc of letter to Chiron (2302-6146.41)
F B RICE	RLR - reminder of rsp due 11-Sep-02 (2302-1413.44)
PTO	monthly statement of deposit account; closing balance 4265.00
J A KEMP	cc of letter (oral proceedings minutes) to Chiron
PTO	Office Action, PTO-892, 4 cited refs (5050-0022)
Cygnus	GRF - copy of PCT published application - 2750-0240.40
Cygnus	GRF - copy of PCT published application - 2750-0242.40
Cygnus	GRF - copy of PCT published application - 2750-0243.40
Marvel, O'Farrell & Mairal	brief requesting examination & invoice \$707.50 (9001-0042.41) - arrived via DHL courier, was sent to 90 Middlefield #180

March 25, 2002

FED EX

RLR 0800-0021 signed declaration

US MAIL - courier pickup

DSP 8325-0011 Notice re Acceptance of Fee Deficiency
DSP 3930-0911 Recorded Assignments (two)
DSP 8325-0027P2 Copy of Provisional Appln filed 3/21/02

RLR 9325-0001.40 Invitation to Correct Defects
RLR 0800-0024 Updated Filing Receipt
RLR 2300-0115.43 Yamamoto ltr re OA
RLR 9001-0016.66 CPA annuity receipt
RLR 9001-0033.44 CPA annuity receipt
RLR 0800-0009.41 CPA annuity receipt
RLR 0800-0009.51 CPA annuity receipt
RLR 5100-0005.40 IPER

NSB 5100-0002.42 Barovsky insts to pay annuity

GRF 9400-0002 ref from E. Johnson
GRF 2750-0241.40 copy of published PCT from B. McBrayer

US MAIL - mailman pm delivery

SL various CPA reminder notices

GRF 9400-? PXE-012.US Office Action

RLR 2300-0401.45 Kemp ltr re discussion w/Exr
RLR 2302-1238.40 Yamamoto ltr re assignment filed
RLR 9001-0048.44 Gowling ltr re confirmatory assignment
RLR 5050-0015 Office Action
RLR 3941-0001.20 Issue Notification
RLR 0800-? SN09/449,581 Issue Notification

DSP 6750-0002 Updated filing receipt

March 26 Mail Log

SL BNA Int'l. info re: subscription to world intellectual property report
DSP RO/US 8325-0011.41 PCT/RO/102, /105, /106
SL Baldwin Shelston Waters Invoice \$2,428.75
DSP Mewburn Ellis 8325-0007.43 designation fees/deadline 14 April 2002
DSP PTO 2225-0017P OFR

US Mail (pm delivery)

DSP 8325-0029P executed assignment from S. Brennan
DSP 8325-0010.40 copy of Written Opinion from S. Brennan
DSP 2300-0999.43 Kemp ltr w/filing receipt
DSP 3930-1000.01 PTO corrected filing receipt
DSP 6750-? Phillips Ormonde ltr re deadline for requesting exam
DSP 2300-15900 copy of Written Opinion from Chiron

RLR 5050-0040P PTO filing receipt
RLR 8900-0002.01 Notice of Abandonment

GRF 2750-0231 copy of corrected OFR from B. McBrayer

March 27, 2002

VIA DHL

RLR 9003-0001.40 executed POA and Power to Inspect

VIA FEDEX

DSP 8600-0010.40 executed appt of agent
DSP 8600-0007.40 executed appt of agent

VIA UPS

RLR 9002-0016.01 Novartis ltr re response to Final OA

US MAIL (pm delivery)

DSP 8325-2009.40 S. Brennan ltr re national phase instructions
DSP 8325-0007.42 Gowlings ltr re natl phase entry
DSP 6750-0007.41 Stanford insts to request examination

March 28, 2002

VIA FEDEX

DSP	8325-0021.40	formal drawings
RLR	5050-0032.40	appt of agent
RLR	5050-0031	signed declarations

VIA UPS

DSP	6210-0004	Jensvold returning assignment?
DSP	2300-1360	Advisory Action from R. Hale

US MAIL to 90 Middlefield Rd. (Delivered by B. Barnes)

DSP	2300-0037.04	copy of filing receipt
GRF	9400-0013.40	Notice of Receipt of Demand
GRF	9400-0013.40	Written Opinion
GRF	2302-1631.21	Notice to Comply

EXPRESS MAIL

DSP	8325-0007.44	Yamamoto ltr re appln filed
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March 29, 2002

US MAIL

RLR	9000-0057.42	Philippine assoc confirmation copy
RLR	9000-0055.42	Philippine assoc confirmation copy
RLR	7777	B. Barnes ltr re 2001 operating expenses
DSP	2300-1651	Hale ltr re draft claims ok

MAIL LOG
April, 2002

<u>ATTY</u>	<u>DOC #</u>	<u>DESCRIPTION</u>
RLR	9001-0033.44	CPA-Official Receipt
RLR	9001-0016.66	CPA-Official Receipt
RLR	0800-0009.61	CPA-Official Receipt
RLR	0800-0009.41	CPA-Official Receipt
DSP	3930-8000	signed receipt of Assignment
RLR	222-0020	signed receipt of Assignment
RLR	5050-0012	PTO-Notice of Allowance
GRF	2750-0233	ltr w/copy of Notice of Allowance
DSP	8325-0010.40	PCT-Written Opinion
RLR	9003-0001	PTO-Filing Receipt
RLR	2300-0953.52	copy of ltr fr Chang w/english version of Amendment (two copies)
RLR	2300-1679	memo fr Guth w/copy of Office Communication
RLR	2300-1679.40	memo w/copy of PCT Written Opinion
DSP	5050-0031.40	PCT-Communication in Cases for Which no Other Form is Applicable
RLR	9000-0040.56	CPA-Official Receipt
RLR	9001-0001.40	ltr fr Gowlings re reponse due, signed POA; new formal drawings; copy of Appl.
RLR	9000-0049.45	ltr fr Gowlings re POA
RLR	5050-0025	PTO-Updated Filing Receipt
RLR	0800-0017.44	CPA-Official Receipt
DSP	3930-0909.42	ltr fr Gowlings w/copy of Notice of National Entry
RLR	3950-0001.40	PCT-Notification of the Recording a Change
DSP	8325-0012.40	PCT-Notification of the Recording a Change
DSP	8600-0002.40	PCT-Notification of the Recording a Change
DSP	6750-0002.40	PCT-Notification of the Recording a Change
DSP	8325-0018.40	PCT-Notification of the Recording a Change
DSP	8325-0019.41	PCT-Notification of the Recording a Change
DSP	8325-0019.40	PCT-Notification of the Recording a Change
RLR	5050-0026.40	PCT-Notification of the Recording a Change
DSP	8325-0023.40	PCT-Notification of the Recording a Change
RLR	9001-0042	PTO-Issue Notification
RLR	2300-0048.EPO	ltr fr Kemp re abandonment
RLR	9001-0015.02	Maintenance Fee reminder
NSB	2302-0402	ltr w/copy of Office Action
RLR	5050-009.40	PCT-Notification Concerning Payment of Prescribed Fees
RLR	2302-0366	ltr w/copy of Final Office Action
DSP	8325-0011	PTO-Office Communication
NSB	2300-1413	ltr fr Fida re amendments
RLR	9003-0001P	PTO-Notice of recordation & Assignment

MAIL LOG
April 2, 2002

ATTY	DOC #	DESCRIPTION
DSP	8325-0009.40	PCT-Notification of Xtl of Intl. Search Report or the Decl.
RLR	5050-0017.40	PCT-Notification of Xtl of Intl. Search Report or the Decl.
RLR	0800-0008.02	ltr w/copy of interview with the Examiner
RLR	0800-0016	ltr w/copy of interview with the Examiner
RLR	0800-0017	ltr w/copy of interview with the Examiner
RLR	5050-0032.40	PCT-Notice Informing the Appl. of the Comm. of the Intl. Appl. to Desg. Offices
DSP	2400-0004.40	PCT-Notification of Recording of a Change
DSP	3930-0911	signed receipt of Assignment
DSP	3930-0909.41	ltr fr Rice w/Direction to Request Examination
DSP	8325-0014.20	PTO-Filing Receipt & Notice to file Missing Parts
DSP	8325-0007	ltr fr Rice w/copy of Entitlement
DSP	860-0004.40	PCT-Notification of Recording of a Change
RLR	5998-0019.42	ltr w/copy of recent publ. Kupfner et al., <i>J. of Immun.</i> <u>167</u> :7044-7051 (2001)
RLR	9000-0049.44	ltr fr Gowlings w/official Notice of Ntl. Entry
GRF	9400-0007.55	conf. copy of ltr fr Yamamoto re claims